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e-mail server, cannot be received, as a result of a judgment made in said judging step.

46. (New) A communication device comprising:

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a reception unit adapted to send a transmit request to an e-mail server and to receive an e-mail transmitted from the e-mail server in response to the transmit request;

an acquisition unit adapted to acquire size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server;

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a memory adapted to store e-mails received by said reception unit;

a judgment unit adapted to judge whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to the size information and a storable capacity of said memory; and

an output unit adapted to visually output warning information indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment unit.

#### REMARKS

This application has been reviewed in light of the Office Action dated May 7, 2002. Claims 29-46 are presented for examination. New Claim 46 has been added to provide Applicant with a more complete scope of protection. Claims 29, 34, and 39 have been amended to define more clearly what Applicant regards as his invention. Claims 29, 34, 39, and 46 are in independent form. Favorable reconsideration is requested.

A claim for priority under 35 U.S.C. § 119 and a certified copy of the priority document for this application were filed in the parent of the present divisional application, Application No. 09/112,318. Applicant respectfully requests acknowledgment of the claim for foreign priority and the receipt of the certified copy.

The Office Action rejected Claims 29-45 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,765,170 (Morikawa) in view of U.S. Patent No. 5,619,648 (Canale et al.). Applicant submits that independent Claims 29, 34, and 39, together with the claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The aspect of the present invention set forth in Claim 29 is directed to a communication device that includes reception means, acquisition means, a memory, judgment means, and output means. The reception means sends a transmit request to an e-mail server and receives an e-mail transmitted from the e-mail server in response to the transmit request. The acquisition means acquires size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server. The memory stores e-mails received by the reception means. The judgment means judges whether or not it is possible for the communication device to receive an e-mail stored in the e-mail server, according to the size information and a storable capacity of the memory. As a result of a judgment by the judgment means, the output means visually outputs warning information indicating that an e-mail to the communication device, stored in the e-mail server, cannot be received.

Morikawa, as understood by Applicant, relates to an electronic mail processing

system that uses specific data in a data file, which is received in e-mail, to classify the data file. The data file is then stored in a folder based on its classification. The Office Action asserts that Morikawa discloses all the elements of Claim 29 except for the output means, which visually outputting warning information, and alleges that Canale et al. remedies this deficiency.

Canale et al., as understood by Applicant, relates to techniques for routing unaddressed e-mail to a mailbox deemed to be appropriate, based on model information that includes keywords describing the expertise of a prospective recipient.

Applicant submits that a combination of Morikawa and Canale et al., assuming such combination would even be permissible, would fail to teach or suggest a communication device that includes "judgment means for judging whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to the size information and a storable capacity of said memory," and "output means for visually outputting warning information indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment means," as recited in Claim 29.

The Office Action points to Canale et al.'s mail filter 109 as disclosing the output means of Claim 29, and states, *inter alia*, in section 3 that, unlike Morikawa, Canale et al. discloses an output means for visually outputting warning information indicating that an e-mail cannot be received. Applicant respectfully traverses the characterization of Canale et al. presented in the Office Action for at least the reason that Canale et al.'s alleged warning cannot be a *warning* because Canale et al.'s e-mail is actually *received* by one of appropriate expertise (see column 2, lines 34-44). That is, the e-mail is received if a prospective recipient's keyword

matches a keyword of the e-mail. Applicant submits that a warning would involve notice *in advance* of an unfavorable occurrence; Canale et al. does not disclose any notice *in advance*. Instead, Canale et al. provides an *acknowledgment* of who received the mail to the sender (see column 2, lines 45-48). The communication device of Claim 29, in contrast, provides a visual warning, *before transmission* of mail, if it would not be possible to receive the mail transmission because of size information and an insufficient storable capacity of the memory. Therefore, Applicant submits that neither Morikawa nor Canale et al. teaches or suggests the output means of Claim 29.

Further, neither Morikawa nor Canale et al. discloses judging whether or not it is possible to receive an e-mail, based on acquired size information and a storable capacity of a memory, as claimed in Claim 29.

Accordingly, Applicant submits that Claim 29 is patentable over the cited art, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). Independent Claims 34 and 39 are method and memory medium claims corresponding to Claim 29, and are believed to be patentable for at least the same reasons as discussed above. Additionally, independent Claim 46 corresponds to Claim 29, written without "means-plus-function" language. Accordingly, Claim 46 also is believed to be patentable for at least the same reasons as discussed above.

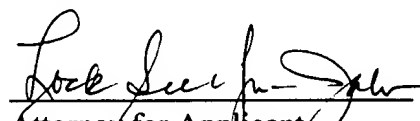
The other claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the

invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE TO CLAIMS

29. (Thrice Amended) A communication device comprising:

reception means for sending a transmit request to an e-mail server and receiving an e-mail transmitted from the e-mail server in response to the transmit request;

acquisition means for acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server;

a memory for storing e-mails received by said reception means;

judgment means for judging whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to the size information and [an empty] a storable capacity of said memory; and

output means for visually outputting warning information indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment means.

34. (Thrice Amended) A communication method, comprising the steps of:

sending a transmit request to an e-mail server and receiving an e-mail transmitted from an e-mail server in response to the transmit request;

acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server;

storing e-mails received in said receiving step, in a memory;

judging whether it is possible or not to receive an e-mail stored in the e-mail server, according to the size information and [an empty] a storable capacity of the memory; and  
visually outputting warning information indicating that an e-mail, stored in the e-mail server, cannot be received, as a result of a judgment made in said judging step.

39. (Thrice Amended) A computer-readable memory medium  
storing executable code for performing a communication method that comprises the steps of:  
sending a transmit request to an e-mail server and receiving an e-mail transmitted  
from an e-mail server in response to the transmit request;  
acquiring size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server;  
storing e-mails received in said receiving step, in a memory;  
judging whether it is possible or not to receive an e-mail stored in the e-mail server, according to the size information and [an empty] a storable capacity of the memory; and  
visually outputting warning information indicating that an e-mail, stored in the e-mail server, cannot be received, as a result of a judgment made in said judging step.